

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

THE SAVINGS BANK LIFE : CIVIL ACTION
INSURANCE COMPANY OF :
MASSACHUSETTS :

v. :

SBLI USA MUTUAL LIFE INSURANCE :
COMPANY, INC. : NO. 00-3255

DECISION AND ORDER

Plaintiff Savings Bank Life Insurance of Massachusetts (Plaintiff) seeks to preliminarily enjoin Defendant SBLI USA Mutual Life Insurance Company, Inc. (Defendant) from using the SBLI USA designation, in connection with the sale of life insurance in New Jersey and Pennsylvania and on the worldwide web.

BACKGROUND FACTS

For purposes of the present Motion for Preliminary Injunction, the parties have stipulated as follows:

In 1907 the Legislature of the Commonwealth of Massachusetts adopted an insurance system intending to provide safe, sound and low-cost life insurance to working people in Massachusetts. This system was authorized through the enactment of Chapter 178 of the Massachusetts General Laws. Under this law, Massachusetts savings banks were authorized to sell and issue life insurance policies to persons who resided or worked in Massachusetts through separate insurance departments that each participating bank was authorized and required to establish and maintain.

Sometime around 1938, the Savings Bank Life Insurance Council (“the Council”) was created as an association of savings banks that participated in the system. On December 31, 1990, the Commonwealth of Massachusetts enacted legislation repealing chapter 178 of the Massachusetts general laws and replacing it with a new chapter 178A effective December 31, 1991. Among other things, chapter 178A abolished the separate insurance departments of the various savings banks that had underwritten life insurance pursuant to chapter 178; abolished the council; created Plaintiff as a separate corporation; transferred the assets of the life insurance departments of those savings banks that had theretofore sold life insurance pursuant to chapter 178 to Plaintiff; provided that it would assume the obligations of any contract of insurance previously entered into by any of those life insurance departments; and authorized Plaintiff to underwrite new life insurance policies. Plaintiff commenced business operations on December 31, 1991 under the name The Savings Bank Life Insurance Company of Massachusetts.

Under chapter 178A, Plaintiff is no longer subject to the requirement that it insure only persons who either reside or work in Massachusetts. Plaintiff has expanded its business operations into New Hampshire, Rhode Island and Maine. Plaintiff received regulatory approval to sell life insurance products and services in Pennsylvania on June 25, 2000 and has applied for approval to sell life insurance products and services in New Jersey.

For the purposes of the present motion, the parties have also stipulated as follows:

In March 1938, the State of New York enacted legislation establishing a life insurance system modeled after the system created by chapter 178 of the Massachusetts General Laws authorizing New York savings banks to sell and issue life insurance to persons who reside or work in New York state. In 1940, the New York legislature created the Savings Banks Life

Insurance Fund (the “Fund”) as a quasi-public corporation to oversee this system. In 1998, the New York legislature enacted enabling legislation that authorized the reorganization of the business conducted by the savings banks that participated in New York’s life insurance system. This legislation authorized the transfer of that business to a corporation specifically authorized by the statute and licensed as a mutual life insurance company. Ultimately under this legislation, Defendant was created and commenced business operations on January 1, 2000 under the name SBLI Mutual Life Insurance Company of New York, Inc. Effective as of April 12, 2000. Defendant changed its name to SBLI USA Mutual Life Insurance Company, Inc.

Under the new legislation, Defendant is not restricted to the sale of its insurance products and services to individuals who reside or work in the state of New York. Defendant has begun to implement a plan to market its products and services to persons who neither work nor reside in New York. Defendant received regulatory approval to sell life insurance products and services in Pennsylvania on March 17, 2000 and in New Jersey on June 9, 2000.

Since January 2, 1942, the state of Connecticut has authorized the sale of savings bank life insurance in that state. Currently, Savings Bank Life Insurance of Connecticut offers life insurance plans for people who live and work in Connecticut through licensed representative at savings banks throughout Connecticut. It is also licensed to do business in Massachusetts and maintains a site on the worldwide web in which it prominently displays the acronym “SBLI.” On December 17, 1997, Plaintiff filed a trademark application for the term “SBLI” for insurance services, namely, issuing annuities and underwriting life insurance policies. The sworn declaration signed by Plaintiff’s president stated:

“It is my belief that applicant is the owner of the mark sought to be

registered; that to the best of my knowledge and belief no other person, firm, corporation or association has the right to use that mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or deceive and that the facts as set forth in the application are true.”

The application stated that the term “SBLI” was first used by Plaintiff in January 1967, and first used in commerce on April 1, 1996. The trademark office assigned this application a filing date of December 22, 1997 with the serial number 75/408,920 and subsequently issued registration number 2,212,996 for the term “SBLI” on December 22, 1998.

On March 27, 2000, Defendant filed a Petition to Cancel Plaintiff’s Registration of “SBLI” with the Trademark office.

Testimony was taken on Plaintiff’s Motion on August 10, 11 and 29, 2000. From that testimony and the documents submitted we make the following:

FINDINGS OF FACT

1. The Savings Bank Life Insurance Company of Massachusetts (“Plaintiff”) is incorporated under the laws of Massachusetts and maintains its principal place of business at 1 Linscott Road, Woburn, Massachusetts. (Stipulation, ¶ 1)

2. In 1907, the legislature of the Commonwealth of Massachusetts adopted an insurance system intended to provide safe, sound and low-cost life insurance to working people in Massachusetts. This system was established through enactment of chapter 178 of the Massachusetts General Laws. This law authorized Massachusetts savings banks to sell and issue life insurance policies to persons who resided or worked in Massachusetts through separate insurance departments that each participating bank was authorized and required to establish and maintain. (Stipulation, ¶ 2)

3. As this system evolved, its operations became increasingly centralized. In or about 1938, the Savings Bank Life Insurance Council (the “Council”) was created as an association of the savings banks that participated in the system. The Council increasingly assumed administrative responsibilities for, and provided centralized services to, the insurance departments of the savings banks that underwrote life insurance pursuant to chapter 178. (Stipulation, ¶ 3)

4. On December 31, 1990, the Commonwealth of Massachusetts enacted legislation repealing chapter 178 of the Massachusetts General Laws and replacing it with new chapter 178A, effective December 31, 1991. Among other things, chapter 178A abolished the separate insurance departments of the various savings banks that had underwritten life insurance pursuant to chapter 178; abolished the Council; created Plaintiff as a separate corporation; transferred the assets of the life insurance departments of those savings banks that had theretofore sold life insurance pursuant to chapter 178 to Plaintiff; provided that Plaintiff would assume the obligations of any contract of insurance previously entered into by any of those life insurance departments; and authorized Plaintiff to underwrite new life insurance policies. Pursuant to this plan, Plaintiff was created and commenced business operations on December 31, 1991 under the name The Savings Bank Life Insurance Company of Massachusetts. (Stipulation, ¶ 4)

5. At the time it repealed chapter 178 of the General Laws and replaced it with chapter 178A, the Massachusetts legislature also eliminated the geographic restriction that chapter 178 had imposed upon the business operations of life insurance departments of savings banks. Under chapter 178A, Plaintiff is not subject to the requirement that it insure only persons who either reside or work in Massachusetts. Consequently, since the time that chapter 178A became effective, Plaintiff has expanded its business operations into New Hampshire (in or about April

1996), Rhode Island (in or about January 1997) and Maine (in or about October 1997). Plaintiff received regulatory approval to sell life insurance products and services in Pennsylvania on June 26, 2000, and New Jersey on August 7, 2000. (Stipulation, ¶ 5; N.T. 8/10 at 153 (WG); Ex. P-38)¹

6. Today, Plaintiff sells its life insurance through agent banks and directly to consumers through telemarketing. (N.T. 8/10 at 157 (WG))

7. Plaintiff holds a federal trademark registration on the Principal Register (No. 2,212,996) on the unstylized term “SBLI,” which was issued by the United States Patent and Trademark Office (“PTO”) on December 22, 1998. (Ex. P-42)

8. Defendant, SBLI USA Mutual Life Insurance Company, Inc. (“Defendant”) is incorporated under the laws of New York and maintains its principal place of business at 460 West 34th Street, New York, New York. (Stipulation, ¶ 6)

9. In March, 1938, the State of New York enacted legislation establishing a life insurance system modeled upon the system created by chapter 178 of the Massachusetts General Laws and authorizing New York savings banks to sell and issue life insurance to persons who resided or worked in New York state. In 1940, the New York legislature created the Savings Banks Life Insurance Fund (the “Fund”) as a quasi-public corporate body to oversee this system. As in Massachusetts, the life insurance system created by the New York legislature became increasingly centralized over time. (Stipulation, ¶ 7)

10. In 1998, the New York legislature enacted enabling legislation, codified by

¹ Notes of Testimony are cited by date and page number. Witnesses are identified as follows: Allan Beale (AB); Richard Peters (RP); William Gaffney (WG); Rose Conneely (RC); Robert Sheridan (RS); Theodore Fuller (TF); Debra Klugman (DK); Robert Brawders (RB); Vikki Pryor (VP); Theodore Manno (TM); Michael D. White (MW); John Petraglia (JP); and Timothy Trainor (TT).

amendments to Article VI-A of the N.Y. Banking Law, and by adding N.Y. Insurance Law § 7316 (hereafter, “Section 7316”), that authorized the reorganization of the business conducted by the savings banks that participated in New York’s life insurance system. This legislation authorized the transfer of that business to a corporation specifically authorized by the statute and licensed as a mutual life insurance company. The statute provided that this transfer was to occur pursuant to a plan to be approved by the applicable regulatory authorities of the State of New York. Following the enactment of this legislation, the conversion plan contemplated by the statute was in fact submitted to and approved by the applicable regulatory authorities of the State of New York. Pursuant to this plan, Defendant was incorporated on August 30, 1999 and commenced business operations on January 1, 2000 under the name SBLI Mutual Life Insurance Company of New York, Inc. Effective as of April 12, 2000, Defendant changed its name to SBLI USA Mutual Life Insurance Company, Inc. (Stipulation, ¶ 8)

11. Under Section 7316, Defendant is not restricted to the sale of its insurance products and services to individuals who reside or work in the State of New York. In view of this statutory change, Defendant has begun to implement a plan to market its products and services to persons who neither work nor reside in New York. Defendant received regulatory approval to sell life insurance products and services in Pennsylvania on March 17, 2000 and in New Jersey on June 9, 2000. (Stipulation, ¶ 9)

12. Currently, Defendant is awaiting the review and approval of its insurance products by the Insurance Departments of the States of New Jersey and Pennsylvania. (N.T. 8/10 at 236-237 (RB)) Upon approval by the relevant regulatory authorities, Defendant intends to begin marketing and selling its insurance products in New Jersey and Pennsylvania. (N.T. 8/10 at 237 (RB))

13. To further its efforts to conduct business in Pennsylvania, Defendant has entered into negotiations for agency agreements with Pennsylvania-licensed insurance agencies. (N.T. 8/10 at 234-36 (RB))

14. On or about March 14, 2000, Defendant filed a petition with the PTO pursuant to 15 U.S.C. § 1064 seeking the cancellation of Plaintiff's registration of "SBLI." (Complaint, ¶ 26 & Ex. 5 thereto)

15. By this motion, Plaintiff seeks to preliminarily enjoin Defendant from using the mark "SBLI" in connection with the sale of insurance in New Jersey and Pennsylvania and on the worldwide web.

16. Defendant used the acronym "SBLI" as a mark and as a component of a logo on its insurance policies as early as 1948. The logo consisted of a shield bearing the letters "SBLI" and appeared in each of the four corners of the face page of every insurance policy. (N.T. 8/10 at 215(JP), 8/11 at 84 (TF); Ex. D-77, Tab 1) The following year an additional, much larger rendition of the logo was added to the center of the policy declaration page. (N.T. 8/11 at 85 (TF); Ex. D-77, Tab 2) This form remained in use until 1964, when the shield logo, still bearing the letters "SBLI" was moved to the top of the declaration page. (N.T. 8/11 at 87 (TF); 8/29 at 60-67 (TM); Exs. D-38, 39, 41, 42, 77, 212, 213, 215, 216 & 217)

17. By the early 1950's, Defendant was using the acronym "SBLI," in the shield logo form as well as in unstylized form, in advertising brochures. (N.T. 8/11 at 85-86 (TF); Exs. D-77, Tab 3)

18. As early as 1956, Defendant began continuously using the "SBLI" shield logo on its annual dividend illustration brochure. (N.T. 8/11 at 87, 92, 94 & 98 (TF); Exs. D-77, Tabs 6, 8, 10 & 12)

19. In or about 1968, Defendant introduced a new "SBLI" logo, referred to as the "razor blade," . (N.T. 8/11 at 103 (TF); Ex. D-77, Tab 17) This logo appeared on applications, policy forms,

newsletters, brochures, letterhead, dividend illustration brochures, and signs until the late 1990's. (See, e.g., Exs. D-36, 37, 40, 43, 44, D-77 & 78, passim)

20. Defendant has advertised widely on radio. Its radio ads have used the acronym "SBLI" and included a musical jingle which also used the "SBLI" acronym:

*With S . . . B . . . L . . . I, you're worth more alive;
'Cause S . . . B . . . L . . . I leaves you more money for living.*

(N.T. 8/10 at 223 (JP), 8/11 at 109-110 & 145-148 (TF); Exs. D-87 & D-208)

21. As early as 1986, Defendant adopted a toll-free number, 1-800-GET-SBLI, which used "SBLI" as a mnemonic. (Ex. D-165) Plaintiff adopted a similar toll-free number, 1-888-GET-SBLI, in 1995. (N.T. 8/10 at 157-58 (WG))

22. Plaintiff concedes that Defendant has continuously made trademark uses of the acronym "SBLI" from 1968 to the present. (N.T. 8/29 at 81-82 (Statement of Counsel)) The evidence shows, however, that this continuous use began at least 20 years earlier, when Defendant began placing the shield logo on all of its insurance policies and many of its advertising materials. The fact that the shield logo or unstylized uses of the acronym "SBLI" to designate Defendant did not appear on all of Defendant's advertising materials does not negate continuity of use. (N.T. 8/11 at 142 (TF))

23. Defendant's use, moreover, was use in interstate commerce. Defendant was, at all relevant times, able to sell to residents of states other than New York who regularly worked in New York. Defendant's New York policyholders were free to, and did, move to other states and take their coverage with them. Defendant would continue to collect premiums from out-of-state policyholders. Defendant's term insurance policies included whole life conversion privileges which could be, and were, exercised by policyholders outside of New York. Ownership of Defendant's policies was freely transferable, and Defendant would then deal with transferee owners from other states with respect to the terms, conditions and benefits of their existing policies. (N.T. 8/29 at 77-80 & 91-95 (TM) & Exs. D-

218 & D-220 - D-224)

24. None of the foregoing information relating to Defendant's use of "SBLI" was provided to the PTO in the prosecution of Plaintiff's application for federal registration. (Ex. P-105)

25. Plaintiff's application to federally register "SBLI" claimed a date of first use in commerce of April 1, 1996, and the date of first use anywhere of January 1967. (N.T. 8/11 at 7 and 9 (RS); Ex. P-40) A subsequent search of Plaintiff's marketing materials indicated that the Plaintiff first used the term "SBLI" as a trademark in 1962. (N.T. 8/11 at 10 (RS))

26. On its early policy forms and some promotional materials, from 1915 to approximately 1934, Plaintiff used a design featuring the interlocking letters "MSBLI" for "Massachusetts Savings Bank Life Insurance." These early materials did not use the term, or any design incorporating, "SBLI." Use of this "MSBLI" design was discontinued in the late 1930's. (N.T. 8/10 at 34-36 & 44 (AB); Exs. P-6 & P-7)

27. From the late 1930's through the early 1960's, Plaintiff used the term "Savings Bank Life Insurance" within a design comprising an outline of the State of Massachusetts on policy forms, newsletters and advertising materials. The acronym "SBLI" did not appear at all. (N.T. 8/10 at 44-47 (AB); Exs. P-1 & D-154)

28. In 1947, approximately the time Defendant adopted the "SBLI" shield logo, Plaintiff's advertising firm noted in a letter to the president of Plaintiff, Clyde Casady, that its policy was not to include the term "SBLI" in advertising materials because some member banks objected to its use. (N.T. 8/10 at 50-53; Ex. D-163)

29. During the late 1950's and early 1960's, Plaintiff used a logo design featuring the words "Savings Bank Life Insurance" spelled out in a rectangle rendered in perspective on insurance policies, point-of-sale displays and brochures. The acronym "SBLI" was not used. (N.T. 8/10 at 47-49 (AB);

Exs. D-140, 141 & 142)

30. In 1962, Plaintiff, by recommendation of its Advertising Committee after conducting a market survey, decided that it needed to create “an effective ‘trade-mark’ . . . to increase identification and recognition, which, as noted in the survey is rather low.” (N.T. 8/10 at 29 (AB); Ex. P-1 at p. 9) Consequently, in 1962, Plaintiff adopted a new logo design using the letters “SBLI” as a trademark. (N.T. 8/10 at 32 (AB); Ex P-1 and P-2)

31. Until this year, Defendant was by statute limited to offering its insurance products to persons who lived or regularly worked in New York. Nonetheless, as of June 29, 2000, it had 22,179 policyholders in New Jersey and 4,658 in Pennsylvania. (Ex. D-132) This is likely the result of the fact that many residents of New Jersey and Pennsylvania commute to work in New York, as well as the fact that New Yorkers who own policies are more likely to change their residence to neighboring states than to more distant ones. (N.T. 8/29 at 115 & 117-18 (TM); 8/29 at 219 (TT))

32. Defendant has advertised for decades in New York media, especially New York City media, which substantially “spill-over” to New Jersey and Pennsylvania. (N.T. 8/29 at 7-15 (RB), 8/29 at 210-16 (TT); Exs. D-230 – D-237)

33. None of the foregoing information regarding Defendant’s penetration of the New Jersey and Pennsylvania markets was provided to the PTO in the prosecution of Plaintiff’s application for federal registration. (Ex. P-105)

34. In contrast to Defendant’s totals, as of June 30, 2000, Plaintiff had only 2,428 policies in force in New Jersey and 2,426 in Pennsylvania. (Ex. D-14)

35. Until 1997, Plaintiff limited its advertising activity to the State of Massachusetts. It has never, to this day, advertised in markets outside of New England. (N.T. 8/10 at 160-162 (WG))

36. Plaintiff’s interest in seeking licensure in Pennsylvania arose when the law firm that was

working on Plaintiff's application in New Jersey expressed a willingness to help them get a license in Pennsylvania because the law firm had an office in Pennsylvania. (N.T. 8/11 at 34 (RS))

37. A court may rely on a variety of forms of evidence to determine whether a term functions as a trademark, including: competitors' use; plaintiff's use; dictionary definitions; media usage; testimony of persons in the trade; and consumer surveys. 2 J. McCarthy, Trademark and Unfair Competition, §§12:13-14 (1999). Here, all of these forms of evidence support the conclusion that the unstylized term "SBLI" (without any associated design, musical setting or other distinctive element) is primarily a generic abbreviation for "savings bank life insurance" and does not serve to uniquely identify any one source of life insurance.

38. Plaintiff was well-aware of Defendant's use of "SBLI" for many years and never objected to it. (N.T. 8/10 at 60 (Statement of Counsel)) Indeed, it was not until 1999, more than 50 years after Defendant began using "SBLI," that Plaintiff objected. (N.T. 8/11 at 40 (RS), 8/29 at 129 (TM))

39. Savings Bank Life Insurance has also been authorized in Connecticut since 1941. (Ex. D-79, Tab 1 at p.570) The Savings Bank Life Insurance Company of Connecticut -- which is licensed to do business in the neighboring state of Massachusetts -- also uses the term "SBLI," in stylized (reproduced below) and unstylized form, to identify itself and its products on advertising, on worldwide website, and in its toll-free telephone number, 1-800-252-SBLI. Plaintiff to this day, has never objected to this use of "SBLI" by this competitor. (N.T. 8/10 at 182-185; Exs. D-9 & D-146)

40. Plaintiff has, for decades past and right up until today, used the term "SBLI" interchangeably to refer to Plaintiff, Defendant and SBLI of Connecticut and to the products any of the three sell. Such usages are inconsistent with its claim of exclusive trademark rights and have contributed to the entry of the term "SBLI" into the common lexicon.

41. Allan Beale was associated with Plaintiff from 1936 to 1976, serving as its president from

1960 to 1976. (N.T. 8/10 at 20-21 (AB)) He testified that throughout his tenure, in ordinary communications, the term “SBLI” was used interchangeably as a handy abbreviation to refer to Plaintiff, Defendant, the Connecticut organization and the product each sold. (N.T. 8/10 at 57 (AB))

42. As early as 1948 and continuing through at least the mid-1960’s, Plaintiff used the term “SBLI” in its internal newsletters and reports to refer interchangeably to Plaintiff, Defendant, SBLI of Connecticut and the products each sold. (N.T. 8/10 at 41-58 (AB); Exs. P-3 & D-79, Tabs 3, 5 & 6)

43. An article by Professor Joel Seligman in the Drake Law Review of 1983-84, “A Federal Depository Institutions Life Insurance System,” makes repeated generic use of “SBLI” to refer to any of the three organizations and their products. For example, he writes that “until the law was amended in 1967, no person in New York could buy more than \$10,000 of SBLI; as late as 1976, no person could buy more than \$5,000 of SBLI in Connecticut.” Notably, the article indicates that Plaintiff’s then-president, Francis Pizzella, reviewed and commented on the article, but evidently did not object to the generic use of the claimed trademark. (N.T. 8/11 at 27-29 (RS); Ex. D-79, Tab 15)

44. In 1995 Plaintiff printed a form, still in use today, to be returned with mail that it believes was wrongly delivered to it. The form, rather than advising the recipient that “SBLI” is a trademark of Plaintiff, makes non-trademark use of the term:

The enclosed materials were received at this office. We have been unable to locate any policy records for the individual indicated therein and are returning the materials to you.

It may be possible that you want either SBLI of New York or SBLI of (Hartford) Connecticut (the three SBLI organizations are not associated with each other).

If you or your customer have any additional information that indicates the existence of a Massachusetts SBLI policy in his name, please forward same and we will be happy to research the matter further. (N.T. 8/10 at 189-91 & 200-201 (RC); Ex. P-46)

45. In correspondence with top officers of Defendant, Mr. Sheridan commonly referred to both Defendant and Plaintiff as “SBLI” and “SBLI systems.” (N.T. 8/11 at 45-46; Ex. D-60) Mr. Sheridan viewed “SBLI” as a convenient shorthand for “savings bank life insurance.” (N.T. 8/11 at 11-12) As recently as February 19, 1998, after he had executed an application for federal registration of “SBLI” for Plaintiff, Mr. Sheridan wrote to Defendant’s acting president, Theodore Manno:

I enjoyed the meeting yesterday. You and Cliff are cheap dates. So much for the gourmet breakfast. In thinking about the Red Sox/Yankees rivalry, I like the idea. Upon further reflection, what about us exploiting the acrimony between the Pats and Jets and establish the “Brandeis Bowl”? Based on wins and points, the home SBLI could hold the bowl. (Ex. D-65)

46. Ten months before filing its trademark application for “SBLI”, Mr. Sheridan co-signed a letter with the presidents of Defendant and SBLI of Connecticut, addressed to the Undersecretary of the United States Treasury, in which the term “SBLI” was used interchangeably to refer to a type of life insurance product and to the three different organizations. (N.T. 8/11 at 51-52 (RS); Ex. D-2)

47. In order to lobby Congress for a change in the tax code which it desired, Plaintiff enlisted the help of Defendant and SBLI of Connecticut in 1997, 1998 and 1999 in order to get the support of their respective state Congressional delegations. (N.T. 8/11 at 49-60 (RS); Ex. D-6)

48. In 1997, in its efforts to lobby to change the tax code, Mr. Sheridan drafted and signed another “three presidents” letter – this one addressed to numerous Senators and Representatives -- in which the term “SBLI” was used interchangeably to refer to all three organizations and the product they sell. (N.T. 8/11 at 52-54 (RS); Exs. D-3 & P-43)

49. Plaintiff has not used the “TM” abbreviation with the term “SBLI” in its advertising or

marketing. (N.T. 8/10 at 156 (WG)) In its radio advertisements, Plaintiff does not claim, or otherwise indicate, that “SBLI” is a registered trademark of the Savings Bank Life Insurance Company of Massachusetts. (N.T. 8/10 at 169 (WG) (Ex. P-21a)) Prior to filing its application for federal registration of “SBLI,” Plaintiff had never taken any action to protect its alleged trademark rights in the acronym. (N.T. 8/10 at 162-63 (WG), 8/11 at 39 (RS))

50. In 1982, Plaintiff prepared a marketing brochure entitled “BEFORE YOU APPLY FOR LIFE INSURANCE . . . READ THIS OBJECTIVE ADVICE.” (Ex. D-144) The brochure consisted of short quotations from various media publications which praised savings bank life insurance and which are presented as “objective sources.” (N.T. 8/10 at 72 (RP)) Notably, at least three of the articles quoted in the brochure – articles from Boston Magazine, New York Magazine and Consumer Digest -- used the term “SBLI” generically. (Ex. D-79, Tabs 10, 12 & 13)

51. For example, the brochure contained a quote from “The Best Life Insurance Money Can’t Buy” by Donald R. German, from the May/June 1980 issue of Consumer Digest. The heading to that article reads: “Want to buy good coverage at low cost? You’ll have to move to Massachusetts, Connecticut, or New York where SBLI is the answer to high-priced protection.” (Ex. D-79, Tab 13) That article also included an illustration in which the Defendant’s “razor blade” logo is used. Indeed, Plaintiff’s own advertising brochure contained the following quote from the German article:

The conclusions are obvious. For persons residing or working in an SBLI state, the smart money move is to buy any permanent insurance desired through SBLI, then round off with SBLI term, adding commercial term only in those cases where SBLI limits don’t meet the needs of the insured. (Ex. D-144)

52. As Richard Peters, the author of the brochure, conceded, this was an example of Plaintiff’s own advertising using the letters “SBLI” generally to refer to the three companies.

(N.T. 8/10 at 74 (RP))

53. Defendant offered the testimony of Michael D. White, an expert in the field of bank insurance. Mr. White agreed that consumers typically obtain their information about life insurance “through professional insurance people, advisors, insurance agents and through the media.” (N.T. 8/29 at 152 (MW))

54. Mr. White testified that among insurance and banking professionals, the term “SBLI” is “typically used as a generic acronym for savings bank life insurance. . . . Apart from specific contextual use such as SBLI of New York or SBLI of Massachusetts, it would be treated as a generic term designed to denote a system for selling life insurance through savings banks.” He further testified that this usage has not changed in light of the trend in recent years toward more direct marketing of savings bank life insurance. Insurance and banking professionals “would still refer to the system, the concept, the products, the distribution as being an SBLI program” (N.T. 8/29 at 155-57 (MW))

55. Mr. White’s testimony was abundantly supported by numerous published examples of such uses of “SBLI” in the trade literature, including examples in each of his three books on bank insurance. (N.T. 8/29 at 157-160 (MW); Ex. D-79 at Tabs 22, 30 & 31)

56. The March 29, 1975 issue of The National Underwriter, a weekly trade newspaper of the United States’ leading insurance publishing house, made similar use of the term “SBLI”:

Besides Massachusetts, only New York and Connecticut have SBLI programs. New York does not allow combinations of policies, but does permit a single bank to sell policies with total face amount up to \$30,000. Connecticut, which has been writing SBLI only since the 1930s, limits policies to \$5,000 per individual.

Although legislation to allow SBLI has been introduced in a number of states, it has always been defeated. Proponents of SBLI attribute the opposition to the low cost competitive stance SBLI holds. Detractors contend SBLI is effective only as long as it is limited and closely regulated. (N.T. 8/29 at 149 & 162-63 (MW); Ex. D-79, Tab 9)

57. In a textbook published in 1981 by the Life Office Management Association, Marketing Life and Health Insurance, a lengthy chapter on savings bank life insurance makes repeated non-trademark use of the term “SBLI,” such as:

Despite strong opposition from life insurance agents and companies, laws authorizing SBLI eventually were passed in Massachusetts, New York and Connecticut. . . . By the end of 1980, there was about \$13.3 billion of SBLI in force in the three states combined.

* * *

In New York, but not in Connecticut or Massachusetts, individuals involved in the sale of SBLI must be licensed. . . . These and other advanced training programs are designed to increase the level of competence of SBLI sales and service personnel that in 1980 included thirty-two CLUs and thirty-eight CLU candidates in the three states.

* * *

Cooperative promotional programs in the name of SBLI system include newspaper advertising and radio and television commercials. Much of the growth during the 1970s in SBLI, especially in New York, is attributed to increased use of television. (N.T. 8/29 at 165 (MW); Ex. D-149)

58. In the July 1993 issue of Life Association News, the official magazine of the National Association of Life Underwriters, the largest life insurance trade organization, there appears an article entitled “N.Y. State’s SBLI Group Hole,” containing such non-trademark uses of “SBLI” as:

Massachusetts forged the first savings bank life insurance program in 1907 as a way for working people to buy relatively inexpensive life insurance. Thirty years later, New York and Connecticut initiated SBLI systems of their own.

In the early years of SBLI, limits on face amounts were low. In New York State, SBLI was commonly known as “poor man’s insurance” and was limited to \$30,000 on individual policies. When the limit rose to \$50,000 in 1985, so did sales. In 1986, New York had \$10 billion of SBLI in force; by 1991, the amount had doubled. Among the three states that sell SBLI, the combined total in force was more than \$36 billion. (N.T. 8/29 at 163-64 (MW); Ex. D-79, Tab 20)

59. The Summer 1998 issue of Bank Insurance Marketing magazine includes an article by its current publisher, Andrew Singer, entitled “Dime Savings Connects with Life Insurance.” Under the sub-heading “Moving Beyond SBLI,” Mr. Singer writes:

Because it is a New York savings bank, Dime has been able to sell Savings Bank Life Insurance (SBLI) for decades. But this low-cost term and whole life insurance program that is only available in three states (New York, Connecticut and Massachusetts) has not, in the view of some institutions, kept up with the times. SBLI doesn’t offer 10-year or 15-year level term life insurance, for instance, or estate planning products. In 1995 and 1996 Dime began to look for additional life products.

This quest was accelerated in the wake of Dime’s January 1995 merger with Anchor Bank, an institution with 18 branches in New Jersey. SBLI could not be sold in New Jersey. So Dime began offering more conventional life insurance. “It worked to a certain level,” recalls Mittel. The bank said, “Hmmm, maybe we can sell things other than SBLI.” (N.T. 8/29 at 166-67 (MW); Ex. D-150)

60. In its 1992 report on savings bank life insurance, the FDIC staff adopted the abbreviation “SBLIM” to distinguish Plaintiff from the other SBLI entities, which were referred to as “SBLIF” and “SBLIC”. The FDIC staff concluded, in a collective reference to SBLI systems that existed in three separate states: “In the history of the SBLI system, the FDIC has no record of loss incurred because of these operations.” (N.T. 8/11 at 21 (RS), N.T. 8/29 at 160 (MW); Ex. D-79, Tab 19)

61. The FDIC report is further evidence that the acronym “SBLI” simply does not function by itself as a distinctive trademark designating Plaintiff.

62. In late 1998 and early 1999, approximately the time it received its federal trademark registration on “SBLI,” Plaintiff engaged the firm of Wallace & Washburn to conduct market

research. (N.T. 8/10 at 139-40 (WG))

63. Wallace & Washburn conducted a telephone survey in which it asked:

When you hear the name Savings Bank Life Insurance or SBLI, are you more likely to consider it to be an insurance company like John Hancock, Met Life or Prudential, or are you more likely to consider it be insurance offered through savings banks and SBLI directly?
(Ex. P-36 at p. 39)

64. As stated in Wallace & Washburn's report dated February 1999, "four fifths of respondents (79%) believed that SBLI is an insurance offered through banks or SBLI directly as opposed to being an insurance company." (N.T. 8/10 at 142 (WG); Ex. P-36 at p. 39). The report concluded that "respondents do not understand that SBLI is a company, but instead see it as a product offered by savings banks or through SBLI's home office." (Ex. P-36 at p. 10)

65. Notably, the survey sample was limited to the states where Plaintiff actively promotes itself and where one would expect its "trademark" to be most recognized: Massachusetts, New Hampshire, Maine and Rhode Island. (Ex. P-36 at p. 2) Indeed, even among a subset of the sample made up of people who had already purchased insurance from Plaintiff, an even higher percentage (84.6%) answered that they were less likely to consider "SBLI" to be a company than to be a product. As Mr. Gaffney testified: "Well, the company had hired me as the senior officer in charge of sales and marketing and I just spent millions of the company's dollars promoting SBLI as a brand, and it bothered me that 80 percent allegedly thought this thing was insurance rather than a company." (N.T. 8/10 at 143 (WG))

66. The Wallace & Washburn report is the only survey evidence bearing on the question whether "SBLI" functions primarily as a designation of Plaintiff as a source of insurance or as a generic name for a type of insurance product. It was done in the ordinary course of business, not in the course of litigation. The result strongly supports the conclusion that it is primarily a

generic name for a type of insurance product.

67. The worldwide website of the Life and Health Insurance Foundation for Education, a nonprofit organization formed by several leading life insurance trade organization to promote public understanding of insurance, includes a glossary containing the following definition:

savings bank life insurance (SBLI)

In the United States, life insurance coverage sold by authorized savings banks to people who live or work in the state in which insurance is sold. Savings bank life insurance is permitted in three states – Massachusetts, New York, and Connecticut. (N.T. 8/29 at 167-68 (MW); Ex. D-79, Tab 35)

68. The Random House Dictionary of the English Language 1273 (Unabridged Ed. 1966) (attached hereto as Exhibit A)² contains the following definition:

SBLI, Savings Bank Life Insurance

69. The Acronyms, Initialisms & Abbreviations Dictionary 3220 (12 ed. 1996) (attached hereto as Exhibit B) contains the following definition:

SBLI Savings Bank Life Insurance

70. Plaintiff introduced several small, paperbound abridged dictionaries which contain no entry for “SBLI.” (Exs. P-111 – P-114) The absence of the term from abridged dictionaries, however, is not probative of whether it functions as a trademark - the editors of such compact editions must omit many non-trademark acronyms.

71. The same evidence that has been presented to show the generic nature of the term “SBLI” shows that the alleged mark, at the very least, is highly descriptive of life insurance and cannot have a secondary meaning identifying Plaintiff as the sole source of “SBLI” product or

² The Court may take judicial notice of dictionary definitions. Fed. R. Evid. 201; Azoplate Corp. v. Silverlith, Inc., 367 F. Supp. 711 (D. Del. 1973); aff’d, 506 F.2d 1050 (3d Cir. 1974), cert. denied, 421 U.S. 914 (1975).

service among the consuming public or any relevant public. Quite simply, “SBLI” refers to the life insurance product itself, to a system of three independent organizations in three different states which issue and underwrite the product, and to the corporate name of each of the three different organizations.

72. As early as 1938, Plaintiff and Defendant helped one another with their business. In 1938, Plaintiff loaned its assistant State Actuary to Defendant to help set up the new Savings Bank Life Insurance system in New York. (Ex. P-3)

73. As early as 1948, Plaintiff, Defendant and SBLI of Connecticut participated in annual Tri-State Conferences to discuss common problems, especially marketing. (N.T. 8/10 at 29 (AB); Ex. P-3) In such meetings the term “SBLI” was routinely used to refer to any of the three organizations or their products, but by itself was not sufficient to identify any one company in particular. (N.T. 8/10 at 56-57 (AB)) It was not Plaintiff’s practice to rebuke its sibling companies for calling themselves “SBLI” or to claim it as their trademark. (N.T. 8/10 at 58 (AB))

74. Since as early as the late 1940’s, Plaintiff has cooperated with Defendant with respect to business and legal matters. (N.T. 8/11 at 111 (TF))

75. Plaintiff was well aware of Defendant’s use of the term “SBLI” for many years and never objected to it. (N.T. 8/10 at 60 (Statement of Counsel)) To the contrary, as set forth above, Plaintiff itself used the term “SBLI” to refer to Defendant in communications with Defendant and with third parties.

76. Plaintiff filed an application to register the unstylized term “SBLI” with the United States Patent and Trademark Office (PTO) on December 22, 1997. The application did not state that “SBLI” was an abbreviation for “savings bank life insurance.” Mr. Sheridan signed a sworn

declaration stating, inter alia, that “to the best of my knowledge and belief no other person, firm, corporation or association has the right to use that mark in commerce, either in the identical form or in such near resemblance thereto as to be likely, when applied to the goods or service of such other person, to cause confusion, or to cause mistake, or deceive and that the facts as set forth in the application are true.” No information was provided to the PTO regarding the long history of use of the term by Defendant or by SBLI of Connecticut. (Ex. P-105)

77. Plaintiff did not have a trademark search conducted before it filed its trademark application for “SBLI” with the PTO. (N.T. 8/11 at 73 (RS))

78. Mr. Sheridan signed the application to register the mark “SBLI” with the knowledge that Defendant and SBLI of Connecticut were rightfully using the term “SBLI” as a trademark. (N.T. 8/11 at 5 (RS))

79. Moreover, Mr. Sheridan signed the application knowing that “SBLI” was commonly used to identify the product sold by the three independent “SBLI” systems, that both Defendant and Savings Bank Life Insurance Connecticut had the right to use the term “SBLI” to describe their product, the system and their individual companies.

80. Three entities using trademarks incorporating the acronym “SBLI” have operated in the adjoining states of Massachusetts, Connecticut and New York for over 50 years. In recent years, they have all used toll-free telephone numbers consisting of the last four digits spelling out “SBLI.” All have been advertising on the worldwide web for several years. Despite this, the record is devoid of evidence of consumer confusion at the point of purchasing decisions, and there is surprisingly little evidence of other types of confusion, such as misdirected mail. Given this long history of peaceful co-existence, it cannot be concluded that Plaintiff will be irreparably harmed by Defendant continuing to use “SBLI” on the worldwide web, or by concurrent use of

“SBLI” by Plaintiff and Defendant in New Jersey and Pennsylvania, pending a final hearing.

81. Since 1995, Plaintiff’s toll-free telephone number has been 1-888-GET-SBLI. (N.T. 8/10 at 100 and 127 (WG); Exs. P-15 & P-16). Since at least 1986, Defendant has had the toll-free telephone number, 1-800-GET-SBLI. (N.T. 8/29 at 70 (TM); Ex. D-165) Since at least 1997, SBLI of Connecticut’s toll-free number has been 1-800-252-SBLI. (Ex. D-9)

82. Despite the fact that these nearly identical toll-free numbers have been advertised in the adjoining states of New York and Connecticut, and the three entities have advertised widely using “SBLI,” Mr. Gaffney – Plaintiff’s executive in charge of sales and marketing -- stated that he is unaware of any instances of consumer confusion regarding the term “SBLI.” (N.T. 8/10 at 157 (WG)) Neither Plaintiff’s telemarketers nor its agents from affiliated banks have reported any instances of customer confusion regarding the “SBLI” mark. (N.T. 8/10 at 157 (WG)) Indeed, Mr. Gaffney testified that he had never even become aware until the day of trial that Defendant’s toll-free number was nearly identical. (N.T. 8/10 at 158 (WG))

83. A representative of Plaintiff’s service department testified to instances of misdirected telephone calls and mail. These events, however, do not reflect confusion on the part of consumers at the stage of purchasing decisions, as they involve existing customers with service issues or, frequently, other insurance companies who misdirect forms.

84. Plaintiff also received numerous phone calls in March and April of 2000 from policyholders complaining that lapse, cancellation and overdue notices were sent in error. (N.T. 8/10 at 192-193 (RC)) This was due to the fact that Citicorp, a data link service used to direct payments, mistakenly directed 1,200 premium payments to Defendant’s account instead of Plaintiff’s account. (N.T. 8/10 at 192-194 & 199 (RC)) There was no evidence that this error was due to consumer confusion or could have been prevented in anyway by the injunctive relief

sought here.

85. In this case, the Court sees no need to prevent any party from using “SBLI” anywhere given each party’s strong right to its name or mark. Any possibility of confusion between the parties can be minimized, if not totally eliminated, by each party’s using its name coupled with a distinctive logo.

86. Plaintiff has argued that Defendant is a willful infringer since it has gone ahead with its plans to expand into New Jersey and Pennsylvania notwithstanding knowledge of Plaintiff’s federal trademark registration. As the foregoing shows, however, Defendant had ample grounds on which to doubt the validity of the registration and whether Plaintiff indeed had any superior rights in those states.

87. Granting the relief Plaintiff seeks would force Defendant to expend millions of dollars to create a new identity for the Pennsylvania and New Jersey markets, prevent it from advertising its toll-free “GET SBLI” telephone number which predates Plaintiff’s by many years, and prevent it from using “SBLI” on its website even within New York, where its right to use “SBLI” could not be more clear.

88. Accordingly, the balance of equities and harms favors Defendant.

89. As Mr. Sheridan agreed, they seek “to do well and to do good in providing low cost insurance in the tradition that Justice Brandeis developed.” (N.T. 8/11 at 27 (RS)) The public interest in such products continues today, and this Court is reluctant, pending a final hearing on the merits after full discovery, to enter a preliminary order which may prematurely or unnecessarily impede the dissemination of information regarding savings bank life insurance to New Jersey and Pennsylvania consumers, or which might add unnecessarily to the cost of such insurance.

CONCLUSIONS OF LAW

1.. This Court has subject matter jurisdiction pursuant to 15 U.S.C. § 1121(a), and under 28 U.S.C. §§ 1331 and 1338(a).

2. Plaintiff's motion for a preliminary injunction is governed by Rule 65 of the Federal Rules of Civil Procedure. In deciding whether to grant a preliminary injunction, the court must consider whether: (1) the movant has shown a reasonable probability of success on the merits; (2) the movant will be irreparably injured by denial of relief; (3) granting preliminary relief will not result in even greater harm to the non-moving party; and (4) granting the preliminary relief will be in the public interest. See Council of Alternative Political Parties v. Hooks, 121 F.3d 876, 879 (3rd Cir. 1997). A request for preliminary relief should only be granted if the court is convinced that all factors favor the relief. S&R Corp. v. Jiffy Lube Int'l, Inc., 968 F.2d 371, 374 (3d Cir. 1992).

3. On a motion for preliminary injunction, tried on an expedited basis after limited discovery, the Court is not required to make a conclusive and final determination regarding the validity of Plaintiff's claimed mark and registration, but rather only tentative findings of the most likely outcome based on the present state of the record. See Campaign for Family Farms v. Glickman, 200 F.3d 1180, 1186 (8th Cir. 2000) (noting that district court's findings of fact and conclusions of law on an application for a preliminary injunction are "tentative and provisional, in the sense that different findings . . . might be warranted after a trial on the merits. "); Illinois Tool Works, Inc. v. Grip-Pak, Inc., 906 F.2d 679, 681 (Fed. Cir. 1990) (all findings of fact and conclusions of law at the preliminary injunction stage are subject to change upon the ultimate trial on the merits).

4. Registration of a trademark under the Lanham Act constitutes only prima facie

evidence of a mark's validity and its ownership by the registrant. See 15 U.S.C. §1057(b), 1115(a). Only after a registration becomes incontestable does the registration constitute conclusive evidence of the mark's validity and its ownership by the registrant. See 15 U.S.C. §1115(b).

5. 15 U.S.C. §1119 provides:

In any action involving a registered mark, the Court may determine the right to registration, order the cancellation of registrations, in whole or in part, restore canceled registrations, and otherwise rectify the register with respect to the registrations of any party to the action. Decrees and orders shall be certified by the Court to the Director, who shall make appropriate entry upon the records of the Patent and Trademark Office, and shall be controlled thereby.

6. Lanham Act registration does not shift the ultimate burden of proof, but merely imposes on a challenger of a trademark “the burden of going forward with evidence to meet or rebut the presumption; it does not shift the ultimate burden of proof.” Silverman v. CBS, Inc., 666 F. Supp. 575, 578 (S.D.N.Y. 1987), vacated on other grounds, 870 F.2d 40 (2d Cir.), cert. denied, 492 U.S. 907 (1989); Fed. R. Evid. 301. See also House of Westmore, Inc. v. Denney, 151 F.2d 261, 265 (3d Cir. 1945) (ultimate burden of proving claimed validity of registered trademark rests with registrant); Sylvania Elec. Products, Inc. v. Dura Elec. Lamp Co., 144 F. Supp. 112 (D.N.J. 1956) (same), aff’d, 247 F.2d 730 (3d Cir. 1957).

7. Because Plaintiff is the owner of a contestable federal registration of “SBLI,” there is only a rebuttable presumption that it has exclusive rights to use the trademark throughout the United States, even in geographic areas in which it is not currently selling insurance, except in those areas where Defendant, as senior user, has established continuous prior use. “[A] federal registrant is still subject to the defense of a prior user of the mark who has established a

market in specific markets notwithstanding that senior user's failure to register." Natural Footwear Ltd. v. Hart, Schaffner & Marx, 760 F.2d 1383, 1395 (3d Cir.) cert. denied, 474 U.S. 920 (1985).

8. The grounds for cancellation which are available where the petition is filed within the five (5) year period include Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), include prior use by another, i.e., that the registrant's mark so resembles a mark or name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the services of the registrant, to cause confusion, or to cause mistakes, or to deceive. See Opryland U.S.A., Inc. v. The Great American Music Show, Inc., 970 F.2d 847 (Fed. Cir. 1992); Trademark Board Manual of Procedure §308.02(a).

9. A further ground for cancellation available during the first five years after registration is that the mark is merely descriptive, 15 U.S.C. § 1052(e)(1) and has not acquired secondary meaning. 15 U.S.C. § 1052(f)

10. A further ground for cancellation, available at any time, is that the registrant's mark does not function as a trademark, or is otherwise generic. See Shakespeare Co. v. Silstar Corp. of America, Inc., 9 F.3d 1091 (4th Cir. 1993), cert. denied, 511 U.S. 1127 (1994); International Order of Job's Daughter v. Lindeburgh and Co., 727 F.2d 1087 (Fed. Cir. 1984).

11. While a contestable federal registration is prima facie evidence that the term is not generic, this presumption "bursts" once the challenger presents "sufficient evidence" of genericness. Liquid Controls Corp. v. Liquid Control Corp., 802 F.2d 934 (7th Cir. 1986)

12. A registered mark may be cancelled at any time if it was obtained fraudulently. 15 U.S.C. § 1064(c).

13. Use in commerce is defined by the Trademark Act to mean the bona fide use of a

mark in the ordinary course of trade. 15 U.S.C. § 1127. Specifically, a service mark is used in commerce "when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State" 15 U.S.C. §1127 (emphasis added).

14. The Trademark Act also defines "commerce" to mean all commerce which may lawfully be regulated by Congress. 15 U.S.C. § 1127.

15. A mark is used on goods when it is placed on the goods, or tags or labels or displays associated with the goods, and the goods are sold or transported in commerce. 15 U.S.C. § .

16. To the extent that each of the three unrelated SBLI systems have used SBLI to identify itself, other SBLI systems, its product, and the products of other SBLI systems, SBLI is incapable of acquiring secondary meaning as identifying a product associated exclusively with one source to the exclusion of any others.

17. "An applicant for registration of a trademark is required to exercise uncompromising candor in his communication with the United States Patent and Trademark Office, lest any registration he obtains will be invalid and/or unenforceable. He must not only refrain from making false representations to the United States Patent and Trademark Office, but must make full disclosure of all facts to his knowledge which might bear in any way on the Office's decision to grant the registration sought." T.A.D. Avanti, Inc. v. Phone-Mate, Inc., 199 U.S.P.Q. 648, 655-656. (C.D. Cal. 1978).

18. Even if Plaintiff's registration were not likely to be cancelled, it would not suffice to give Plaintiff superior rights to use "SBLI" in territories where Defendant had previously established common law rights.

19. Plaintiff not only acquiesced in but aided Defendant in using in connection with its

activities of "SBLI" as a name and mark, just as Defendant aided Plaintiff in its activities. The joint efforts of the parties with respect to marketing and with respect to underwriting policies, in addition to the joint lobbying efforts, all demonstrate acquiescence such as bars Plaintiff from now objecting to Defendant's use of SBLI.

20. Plaintiff seeks to rely upon a presumption of irreparable harm. Such a presumption arises only where there has been a “strong” showing of trademark infringement. Opticians Association of America v. Independent Opticians Association of America, 920 F.2d 187, 196 (3d Cir. 1990). Because trademark infringement has been not been shown, and certainly there has been no strong showing, the presumption does not apply. Even if it did, it has been amply rebutted herein.

21. There is no evidence of actionable confusion where there is no evidence that any consumer mistook Defendant for Plaintiff in making an insurance application or actually receiving an insurance policy. First Keystone Federal Savings Bank, 923 F. Supp. at 706.

22. Hence, there is not evidence of any confusion at point of purchase. Confusion is not actionable where it is not shown that the misdirected calls or mail resulted from confusion between the two companies as opposed to mere carelessness or accident. First Keystone Federal Savings Bank, 923 F. Supp. at 706. Any misdirected communications are not shown to have impacted on any purchase decision, and so are not actionable.

23. Further, where lesser measures suffice to protect the interests of the parties and the public, more drastic relief is not appropriate. See Chase Federal Savings and Loan Association v. Chase Manhattan Financial Services, Inc., 681 F. Supp. 771 (S.D. Fla. 1987), where the Court rules at 787:

Bearing in mind that the primary object of the trademark laws is not “protect” trademarks, but is to

protect the consuming public from deception, James Burrough, Ltd. v. Sign of Beefeater, Inc., 540 F.2d 266, 276 (7th Cir. 1976), the Court concludes that in this case there are equitable measures that can easily be taken to prevent consumer confusion and to protect all parties' right to a non-confused public.

24. Such lesser measures are already being taken by the parties, who use very distinct logo designs (indeed, Defendant now uses "SBLI USA" which creates an additional distinction) and who both include their full corporate names in all of their advertising. Particularly in the financial services area, where consumers take greater care than in many others, such differences are sufficient to reduce any confusion. First National Bank, in Sioux Falls v. First National Bank, South Dakota, 153 F.3d 885, 889-90 (8th Cir. 1998); First Savings Bank, F.S.B. v. First Bank System, Inc., 101 F.3d 645, 653 (10th Cir. 1996); Sun Banks of Fla., Inc. v. Sun Federal Savings & Loan, 651 F.2d 311, 319 (5th Cir. 1981); First Bank v. First Bank System, Inc., 909 F. Supp. 657, 661 (S.D. Iowa 1995) (confusion between names "First Bank" and "First Bank Iowa" is reasonably manageable such that equities weigh against permanent injunction), aff'd, 84 F.3d 1040 (8th Cir. 1996).

25. Under the facts and the law, Plaintiff has not proven a probability of success and irreparable harm.

26. Plaintiff is not entitled to a Preliminary Injunction.

An appropriate Order follows.

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

THE SAVINGS BANK LIFE : CIVIL ACTION
INSURANCE COMPANY OF :
MASSACHUSETTS :

v. :

SBLI USA MUTUAL LIFE INSURANCE :
COMPANY, INC. : NO. 00-3255

O R D E R

AND NOW, this 29th day of NOVEMBER, 2000, upon consideration of the Plaintiff's Motion for Preliminary Injunction and the opposition thereto, and for the reasons set forth in the attached Findings of Fact and Conclusions of Law, it is hereby ORDERED that the Motion is DENIED.

BY THE COURT:

ROBERT F. KELLY, J.